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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,533	06/09/2000	EUGENIE CHARRIERE	004900-172	2035

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BURNS DOANE SWECKER & MATHIS
PO BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,533

Applicant(s)

Charriere et al.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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1. Claims 60 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Formula III contains the group, -NX'X''₁; however, the group, -NX'X''₁, has been defined.

2. Claim 70 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, no definition has been provided for structure IV. Contrary to applicants' response, the definition of the structure is not clear, because claim 70 does not depend from claims 60 or 66. The definition must be present within the claim or a claim from which the instant claim depends.

Secondly, the definitions of the NX'X'' variables within claims 69 and 70 do not agree. The variables within claim 70 do not appear to allow for the required variable definitions within claim 69. For example, claim 69 requires that NX'X'' contain an allophanate linkage; however, claim 70 only specifies isocyanate groups, isocyanurate groups, uretidinedione groups, and biuret groups. As such, claim 70 fails to further limit claim 69.

3. Claims 48-51, 55, and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are confusing due to the means by which the claims have been drafted. Due to the use of Markush group language and “and/or”, it is unclear with respect to exactly what linkages or structures are required to be within the scope of the claim. For example, it is not clear that uretidinedione groups are required to be present; however, this is apparently the crux of applicants’ invention. A reasonable interpretation of claim 48, for example, is that only a trimer group is required to be present.

Additionally, the language, “low viscosity”, is subjective language. It cannot be determined what constitutes a low viscosity. Furthermore, since viscosities are highly temperature sensitive, it is unclear that the language provides any meaningful limitation to the claims. Despite applicants’ response, the term has not been defined for compositions which do not contain uretidinedione groups; and as aforementioned, it is not clear that the claims require the presence of these groups.

Lastly, despite, applicants’ response, the claims and specification remain unclear with respect to what catalysts and conditions are encompassed or excluded by “(cyclo)condensation”. The passage within the specification, cited by applicants in their response, appears to be relevant to (cyclo)trimerization, rather than (cyclo)condensation. The distinction between the two is not clear.

4. Claims 48-51, 55, and 68 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions which contain uretidinedione groups, does not reasonably provide enablement for compositions which lack such groups. The specification

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does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants have only provided enablement for the production of low viscosity compositions that contain uretidinedione groups; however, for reasons previously set forth, the claims have been interpreted as not requiring such groups.


5. Claims 39-76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Within the specification, applicants have stated that a significant distinction between the instant invention and the prior art is that the uretidinediones of the instant invention are produced in the absence of a dimerization catalyst. However, applicants further disclose that the reactants of their invention can be reacted in the presence of (cyclo)trimerization catalysts and (cyclo)condensation catalysts. The position is taken that applicants have failed to provide a clear definition of what constitutes a (cyclo)condensation catalyst. Further, one of ordinary skill would have expected that dimerization catalysts are encompassed by (cyclo)condensation catalysts. Also, (cyclo)trimerization catalysts were known to cause such side reactions as the production of uretidinediones. While applicants have disclosed a few examples of the types of dimerization catalysts to be excluded, the examples are by no means exhaustive. The position is ultimately taken that applicants have provided no clear distinction between the disclosed groups of catalysts

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(dimerization, trimerization, and condensation); therefore, it cannot be determined exactly what catalysts or catalytic functions are encompassed or excluded by applicants' claimed processes. It cannot be determined what patentable weight to give the claim limitations that specify an absence of dimerization catalysts.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

January 12, 2003